

**REMARKS**

This Amendment is filed in response to the Office Action dated March 7, 2005. For the following reasons this application should be allowed and the case passed to issue. No new matter is introduced by this amendment. The amendment to claim 1 is supported throughout the specification and further clarifies the scope of claim 1.

Claims 1-3 are pending in this application. Claims 1-3 have been rejected. Claim 1 has been amended.

***Claim Rejections Under 35 U.S.C. § 102***

Claims 1-3 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Obara et al. (U.S. Patent No. 5,843,369). This rejection is traversed, and reconsideration and withdrawal thereof respectfully requested. The following is a comparison between the instant invention as claimed and Obara et al.

An aspect of the invention, per claim 1, is a rolling bearing ring of a constant velocity joint, employing steel of a component composition containing, as alloying elements, at least 0.5 mass % and 0.7 mass % at most of carbon, at least 0.5 mass % and 1.0 mass % at most of silicon, and at least 0.5 mass % and 1.0 mass % at most of manganese with a remainder of iron and inevitable impurities. The rolling bearing ring has a structure in which a raceway surface is subjected to induction hardening.

The Examiner asserted that Obara et al. disclose a rolling bearing ring of a constant velocity joint comprising the claimed steel composition.

Contrary to the Examiner's assertions, Obara et al. do not disclose the claimed steel composition. Obara et al. do not disclose the claimed rolling bearing ring, as the Obara et al. composition is a stainless steel containing 10.5 % to 13.5 % Cr. The rolling bearing of the

present invention is not a stainless steel, and contains only inevitable impurity levels of elements other than those recited in claim 1. One of ordinary skill in this art would immediately recognize that 10.5 % to 13.5 % of Cr is not inevitable impurities. Claim 1 clearly excludes the 10.5 % to 13.5 % of Cr required by Obara et al.

Claims 1-3 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Fukumoto et al. (U.S. Patent No. 5,780,165). This rejection is traversed, and reconsideration and withdrawal thereof respectfully requested. The following is a comparison between the instant invention, as claimed, and Fukumoto et al.

The Examiner averred that Fukumoto et al. disclose a rolling bearing ring of a constant velocity joint comprising the claimed steel composition.

Fukumoto et al., however, do not disclose the claimed steel composition of at least 0.5 mass % of carbon. Fukumoto et al. disclose a composition containing a maximum of 0.4 % carbon, not the at least 0.5 % carbon, as required by claim 1. In addition, the Fukumoto et al. composition contains 3.5 % to 7.0 % Cr, while the rolling bearing of the present invention contains only inevitable impurity levels of elements other than those recited in claim 1. One of ordinary skill in this art would immediately recognize that 3.5 % to 7.0 % of Cr is not inevitable impurities. Claim 1 clearly excludes the 3.5 % to 7.0 % of Cr, required by Fukumoto et al.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the disclosure in a single reference of each element of a claimed invention. *Helifix Ltd. v. Blok-Lok Ltd.*, 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994); *Hoover Group, Inc. v. Custom Metalcraft, Inc.*, 66 F.3d 399, 36 USPQ2d 1101 (Fed. Cir. 1995); *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321

**Application No.: 10/653,199**

(Fed. Cir. 1992); *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051 (Fed. Cir. 1987). Because Obara et al. and Fukumoto et al. do not disclose the claimed steel composition, as required by claim 1, Obara et al. and Fukumoto et al. do not anticipate claim 1.

Applicant further submits that Obara et al. and Fukumoto et al., whether taken alone, or in combination, do not suggest the claimed rolling bearing ring of a constant velocity joint.

Dependent claims 2 and 3 are allowable for at least the same reasons as independent claim 1 and further distinguish the claimed invention.

In light of the above Amendment and Remarks, this application should be allowed and the case passed to issue. If there are any questions regarding these remarks or the application in general, a telephone call to the undersigned would be appreciated to expedite prosecution of the application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Bernard P. Codd  
Registration No. 46,429

600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
Phone: 202.756.8000 BPC:BPC  
Facsimile: 202.756.8087  
**Date: June 7, 2005**

**Please recognize our Customer No. 20277  
as our correspondence address.**